



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/539,151	06/16/2005	Ulrich Berens	VT/95-22814/A/PCT	2741
324	7590	02/04/2009	EXAMINER	
JoAnn Villamizar Ciba Corporation/Patent Department 540 White Plains Road P.O. Box 2005 Tarrytown, NY 10591			NOLAN, JASON MICHAEL	
			ART UNIT	PAPER NUMBER
			1626	
			MAIL DATE	DELIVERY MODE
			02/04/2009	PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/539,151	<b>Applicant(s)</b> BERENS ET AL.	
	<b>Examiner</b> JASON NOLAN	<b>Art Unit</b> 1626	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 24 October 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 18-24,31-36 and 41-43 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 18,19,21,22,24,31-36,41 and 42 is/are allowed.
- 6) ☒ Claim(s) 20,23 and 43 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                                | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                       | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

### **DETAILED ACTION**

This Office Action is responsive to Applicants Amendment - After Non-Final Rejection, filed 10/24/2008. As presently filed, Claims 18-24, 31-36, & 41-43 are pending in the instant application; of which Claims 18, 20, 23, 36, & 41 are currently amended and Claims 42 & 43 are new.

#### ***Response to Amendment***

Applicant's amendments with respect to Claims 18, 20, 23, 36, & 41 have been fully considered and are entered. The objection of Claim 18 has been withdrawn per amendment. The rejection of Claim 20 by US 5,164,372 is withdrawn per amendment. The rejection of Claim 23 over Andersen et al. is withdrawn per amendment. The rejection of Claims 23 & 41 over Porter et al. is withdrawn per amendment. The rejection of Claim 36 is withdrawn per amendment.

#### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

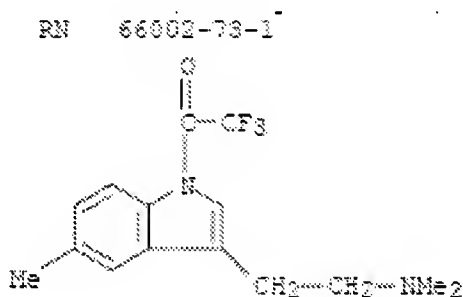
(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claim 20 is rejected under 35 U.S.C. 102(b) as being anticipated by the abstract of Glushkov et al. (Khimiko-Farmatsevticheskii Zhurnal 1992, 26(6), 18-21). Shown in the abstract is formula I wherein R = CH<sub>2</sub>CONMe<sub>2</sub>, R<sub>3</sub> & R<sub>4</sub> = alkyl (Me); R<sub>2</sub> = H; and

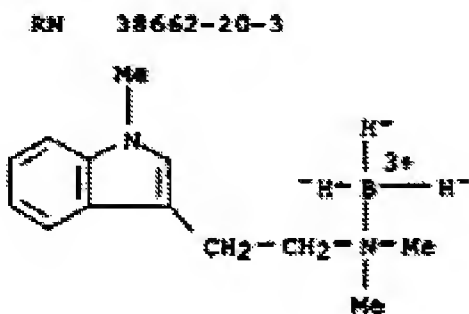
Art Unit: 1626

R1 = OH. Further, a species was found in the registry search pertaining to those substitutions.

Claim 23 is rejected under 35 U.S.C. 102(b) as being anticipated by Oon et al. (Biochemical Medicine 1977, 18(3), 410-19). Shown below is compound RN 66002-73-1, which anticipates formula XIV wherein  $n = 1$ , R1 = alkyl (Me), R3 & R4 = alkyl (Me), and R2 = acyl (C(O)CF<sub>3</sub>).



Claim 43 is rejected under 35 U.S.C. 102(b) as being anticipated by Littell et al. (J. Org. Chem. 1973, 38(8), 1504-10). The borane of compound 15-a is Registry No. 38662-20-3, identified on the bottom right of p. 1509 and shown below anticipates instant formula XIIIa wherein  $n = 0$ , R2, R3, & R4 = Me.



***Allowable Subject Matter***

Claims 19, 21, 22, 24, & 31-35 were previously allowed. Claims 18, 36, 41, & 42 are now allowed.

***Conclusion***

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

***Telephone Inquiry***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jason M. Nolan whose telephone number is (571) 272-4356 and e-mail is [Jason.Nolan@uspto.gov](mailto:Jason.Nolan@uspto.gov). The examiner can normally be reached on Mon - Fri (9:00 - 5:30PM). If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Joseph M<sup>c</sup>Kane can be reached on (571) 272-0699. The USPTO fax number for applications is 571-273-8300. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system, (either Private PAIR or Public PAIR). Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. For questions on Private PAIR system, contact the Electronic Business Center at (866) 217-9197.

/Jason M. Nolan/

Examiner, Art Unit 1626

/Rebecca L Anderson/

Primary Examiner, Art Unit 1626